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APPLICATION NO. 03/412,256	FILING DATE 10/05/99	FIRST NAMED INVENTOR SCHMIDT	ATTORNEY DOCKET NO. C 19384/9069
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EXAMINER

TAWFIK, S

ART UNIT

PAPER NUMBER

3721

DATE MAILED:

04/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/412,256

Applicant(s)

Charles Louis Schmidl

Examiner

Sameh Tawfik

Group Art Unit

3721



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) 24-29 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20, 22, and 23 is/are rejected.

☒ Claim(s) 21 is/are objected to.

☒ Claims 1-29 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, drawn to a separation finger apparatus, classified in class 493, subclass 422.
  - II. Claims 24-29, drawn to a method for inserting a separation finger into a stream of web material, classified in class 493, subclass 410.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case the process as claimed can be practiced by another materially different apparatus such as no translation member mounted for rotation about a first axis and/or no pivot member coupled to the separation finger for rotation about a second axis.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Christ Austin, REG # 41592 on 4/13/2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-29 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Specification***

6. The disclosure is objected to because of the following informalities: "translation block 26" (page 8, line 4; page 9, line 23; page 10, line 3; etc.); "translation block 76" (page 8, lines 19, 22; page 9, lines 1, 4, 6; etc).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Please delete "alone" (claim 1, line 6) and insert --along--;

"The at least" (claim 3, line 2; claim 18, line 3) lack proper antecedent basis.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 13 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Buck et al. (4,673,382).

Buck discloses a separation finger apparatus comprising a separation finger (22) pivotally mounted about a pivot axis (FIG. 4) and also mounted to orbit about an orbit axis located a distance from the pivot axis, see for example (FIGS. 1-5); the separation finger mounted for simultaneous translation and rotation with respect to the stream of web product, see for example (FIGS. 1-5).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1, 2, 4, 6-10, 12, 14-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buck et al. (4,673,382) in view of Bond (4,676,113).

Buck discloses a separation finger apparatus for removable insertion into a stream of web material comprising a separation finger (22); a translation member (73, 74, 75) mounted for rotation about a first axis and being coupled to the separation finger (FIG. 4); a pivot member (77 and 78). Buck does not disclose a translation member having a length along which the separation finger can translate nor a pivot member rotatably coupled to the separation finger. However Bond discloses a pivot member rotatably coupled to the separation finger (48) for rotation about an axis; a translation member (26) having a length along which the separation finger can translate (FIG. 3); the translation member and the pivot member being mounted to a pivot shaft (52) with respect to one another to translate the separation finger (48) in a range of positions upon the length of the translation member between and including a retracted position and an extended position, see for example (FIG. 3) to move the finger in a controlled motion (column 1, lines 7 and 8).

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified Buck's separation finger apparatus by having translation member having a length along which the separation finger can translate, as suggested by Bond, in order to move the finger in a controlled motion.

Regarding claim 2: Buck discloses the pivot member (77 and 78) being mounted for rotation about another axis at a second location on the pivot member (FIGS. 4 and 5).

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Regarding claims 4 and 19: Buck does not disclose that the translation member comprises an element having an aperture. However, Bond discloses that the translation member (26) comprises an element having an aperture (36) and at least a part of the separation finger (48) being secured within and adapted to translate within the aperture (FIG. 3) to move the finger in a controlled motion.

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified Buck's separation finger apparatus by having the translation member comprises an element having an aperture, as suggested by Bond, in order to move the finger in a controlled motion.

Regarding claim 6: Buck discloses a pivot shaft which the translation member being mounted to the first pivot shaft, see for example (FIG. 4).

Regarding claims 7, and 8: Buck discloses that a pivot member (77 and 78) being mounted to a pivot shaft and a second pivot shaft, see for example (FIG. 4).

Regarding claims 9 and 10: Buck discloses that the separation finger (22) and the translation member (73, 74, 75) are secured against rotation with respect to one another, see for example (FIGS. 4 and 5).

Regarding claim 12: Buck discloses that the separation finger (22) has a proximal end to which is coupled the translation member (73 and 74) and a distal end for insertion into the stream of web material, see for example (FIG. 4).

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Regarding claim 15: Buck discloses that the translation member axis and the orbit axis are in fixed relationship with one another, see for example (FIGS. 1-5).

Regarding claim 16: Buck discloses that the separation finger (22) is secured against rotation with respect to the translation member (73 and 74), see for examples (FIGS. 1-5).

Regarding claim 17: Buck discloses that the separation finger is engaged to the translation member near the pivot axis of the separation finger, see for example (FIGS. 1-5).

Regarding claim 18: Buck discloses that the translation member (73 and 74) comprises at least one elongated rod mounted for rotation about the translation member axis (FIGS. 1-5); the separation finger (22) coupled to at least one elongated rod to translate there along in the orbit of the separation finger, see for example (FIGS. 1-5).

Regarding claims 20 and 22: Buck discloses that the translation member (73 and 74) is rotatably secured at the translation member axis to a pivot shaft and a second pivot shaft, see for example (FIGS. 1-5).

***Allowable Subject Matter***

13. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 3, 5, and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



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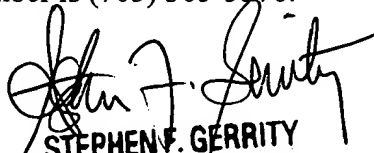
*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. R. A. Harris (3,538,778) and E. G. Lawrence et al. (3,552,828) disclose translation member having a length along which the finger can translate; Couturier (4,770,402), Hauschild et al. (5,730,695), Parkander (4,846,454), and Meschi (5,201,700) disclose separation finger for stacking folded web.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo, can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3576.

  
STEPHEN F. GERRITY  
PRIMARY EXAMINER

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April 21, 2000